

Remarks

Claims 1-17 and 78-80 are pending in the application. Claims 7-17 and 76 have been objected to for depending from a rejected independent claim. Claims 1-6, 74, 75, and 77-80 stand rejected. Claims 7-17 have been amended. New claim 81-83 have been added. Support for new claims 81-83 can be found in original claim 2 in combination with original claims 7, 12, and 14, respectively. Applicant respectfully requests reexamination and reconsideration of the case in light of the following remarks. Each of the rejections levied in the Office Action is addressed individually below.

I. Double Patenting. Claims 1-5, 6, 75, 77, and 78 have been rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-5, 7, 56, 61, and 63 of U.S. Patent 6,218, 118 (the '118 patent). The Examiner states that claim 6 of the '118 patent discloses "that said X-mer precursors of the said mixture of sub-mixture comprise a tag, which inherently teaches that at least one X-mer precursor comprises a tag." The Examiner further states that claims 64-65 of the '118 patent disclose "a cleavable linker with a nucleic acid sequence attached to it, which indicate that the claims in the patent encompass the claim language" in the present application. The Examiner is mistaken.

The independent claims 1 and 2 of the present application recite "wherein each tag is covalently linked to at least one X-mer precursor through a *cleavable linker*" (emphasis added). The claims of the '118 patent do not explicitly, implicitly, or inherently disclose a tag linked to an X-mer precursor by a *cleavable linker*. Claim 6 recites "wherein said X-mer precursors have an ionization tag," but claim 6 does not include a cleavable linker. Claims 64 and 65 recite a cleavable linker between a nucleic acid probe and the surface of an array *not* between an X-mer precursor and a tag. None of the claims of the '118 patent recite an X-mer precursor covalently linked to a tag though a cleavable linker, and therefore, the claims of the '118 patent and the present claims are not coextensive in scope. Applicant requests that the statutory double patenting rejection be removed.

Claims 74, 79, and 80 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 61, 64, and 65 of U.S. Patent 6,218,118. The Examiner states in the latest Office Action that the claims in the '118 patent encompass the limitations in the instant claims and are related as genus and species. Applicant submits that claims 74, 79, and 80 are not obvious in view of the '118 patent;

however, in order to further prosecution Applicant submits herewith a terminal disclaimer disclaiming any portion of the term of a patent that issues from the present application that extends beyond the term of the '118 patent. Applicant submits that the terminal disclaimer submitted herewith removes any basis for an obviousness-type double patenting rejection based on the '118 patent.

In view of the forgoing amendments and arguments, Applicant respectfully submits that the present case is now in condition for allowance. A Notice to that effect is requested.

Please charge any fees that may be required for the processing of this Response, or credit any overpayments, to our Deposit Account No. 03-1721.

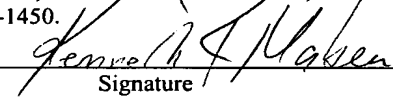
Respectfully submitted,



C. Hunter Baker, M.D., Ph.D.
Registration Number: 46,533

Choate, Hall & Stewart
Exchange Place
53 State Street
Boston, MA 02109
(617) 248-5000
Date: December 1, 2004

3758325v1

Certificate of Mailing	
I certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First-Class Mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
December 1, 2004	
Date	Signature
Kenneth R. Maben	
Typed or Printed Name of person signing certificate	